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09/591,708	06/09/2000	Stuart J. Jacobs	00-8010	2685

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EXAMINER

HA, LEYNNA A

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/591,708

Applicant(s)

JACOBS ET AL.

Examiner

LEYNNA T. HA

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-22 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-6 and 8-22 are pending.
Claims 7 and 23 are cancelled.
2. This is a Non-Final rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 9-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 9 and 13 a cryptographic module which is an abstract idea because the cryptographic module comprises carrying out descriptive material of a memory, a processor, and cryptographic processing programs. Therefore, claims 9-13 are non-statutory. All other claims dependent to claims 9 and 13 are also rejected based on their dependency.

MPEP:

(b) Nonfunctional Descriptive Material

Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35

U.S.C.101. Thus, Office personnel should consider the claimed invention as a whole to determine whether the necessary functional interrelationship is provided. Where certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer. **Such "descriptive material" is not a process, machine, manufacture or composition of matter. (Data consists of facts, which become information when they are seen in context and convey meaning to people.** Computers process data without any understanding of what that data represents. Computer Dictionary 210 (Microsoft Press, 2d ed. 1994).) The policy that precludes the patenting of nonfunctional descriptive material would be easily frustrated if the same descriptive material could be patented when claimed as an article of manufacture. For example, music is commonly sold to consumers in the format of a compact disc. In such cases, the known compact disc acts as nothing more than a carrier for nonfunctional descriptive material. The purely nonfunctional descriptive material cannot alone provide the practical application for the manufacture. Office personnel should be prudent in applying the foregoing guidance. **Nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. 101.** The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter.

For example, a computer that recognizes a particular grouping of musical notes read from memory and upon recognizing that particular sequence, causes another defined series of notes to be played, defines a functional interrelationship among that data and the computing processes performed when utilizing that data, and as such is statutory because it implements a statutory process.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6 and 8-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia, et al. (US 5,825,880), and further in view of Boebert, et al. (US 5,596,718).

As per claim 1:

Sudia teaches in a node operative within a network of a plurality of nodes, a method for performing cryptographic-related functions comprising:

executing an application program at the node which is not physically secured;
(col.7, lines 33-34 and col.8, lines 21-24)

receiving an input requiring cryptographic-related processing; **(col.7, lines 12-13)**
generating a message via the application program based on the input **(col.7, lines 34-52)**, the message representing one of a predefined set of messages **(col.8, lines 10-11 and col.11, lines 6-15)** for processing by a cryptographic processing component **(col.9, lines 9-13)** located within the network node; **[(col.8, line 63 - col.9, line 23) Applicant's node is referred in Sudia as the trusted device or known as a smart card or the signing device. This trusted device comprises a microchip that has a microcontroller for executing programs and a crypto-unit that performs encryption/decryption and signature processes (col.8, line 63 - col.9, line 23). Therefore, Sudia does teach executing the application program and cryptographic processing within the node.]**

transmitting the message to the cryptographic processing component; and **(col.7, lines 41-42)**

performing the cryptographic-related processing by the cryptographic processing component **(col.10, lines 5-46)**.

Sudia discloses human operators work in relatively unsecured areas at desk-top computer or terminals where there includes a card reader for a secure smart card to be inserted (col.8, lines 20-24). The claimed node is the prior art's desktop computer or terminal that can execute application programs to secure components such as the smart card or the signing devices. However, Sudia did not clarify why it would have been obvious to execute an application program at the node that is not physically secured to/from the cryptographic processing component.

Boebert teaches there is a need for a mechanism for extending the trusted path from the trusted subsystem of the host computer to the user of an untrusted computer or workstation such that provide access to the workstation for normal working station activities while shielding confidential data so that it cannot be read by software executing on the unsecured workstation (col.3, lines 14-19). The computer or workstation as recited in Boebert is the claimed node. Therefore, it would have been obvious for a person of ordinary skills in the art at the time of the invention was made to combine the teachings Sudia with the teaching of executing an application program at the node that is not physically secure of Boebert because the method ensures secure file transfers between a user of an unsecured workstation and a trusted computer while shielding confidential data so that it cannot be read by software executing on the unsecured workstation (col.3, lines 21-42).

As per claim 2: Sudia discloses verifying a digital signature wherein includes encrypting and decrypting data (col.6, lines 32-42), retrieving the digital certificate (col.10, lines 15-38), verifying the hierarchy (col.1, lines 24-38), and self-signed certificate processing (col.7, lines 45-52) within the node. Further, Sudia discloses certificate age checking in the form of time stamping (col.9, lines 13-16).

As per claim 3: See col.11, lines 9-22 and col.16, lines 35-67 discusses generating a function call message representing a request for performing a predetermined cryptographic related functions.

As per claim 4: Sudia discloses generating an output message via the application program wherein the output message requiring cryptographic-related processing

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(col.11, lines 6-10), transmitting one of predefined the messages (col.11, lines 10-13) to the cryptographic processing component (col.9, lines 9-13) to perform the cryptographic-related processing (col.9, lines 55-56), and outputting the processed message (col.11, lines 17-18).

As per claim 5:

Sudia teaches a computer readable medium having stored thereon a plurality of sequences of instructions that may be invoked by a plurality of predefined messages executed by a processor in an environment, which is not physically secure (**col.8, lines 21-24**), cause said processor to perform a method comprising:

receiving an input representing one of predefined messages; (**col.8, lines 10-11 and col.10, lines 10-14**)

transmitting, based on the input (**col.9, line 64 – col.10, lines 2**), generating a function call message (**col.8, lines 24-55**) representing a request (**col.11, lines 6-9**) for performing a predetermined cryptographic related functions (**col.11, lines 9-22 and col.16, lines 35-67**); and

perform the cryptographic-related processing (**col.10, lines 15-30**).

Sudia discloses human operators work in relatively unsecured areas at desk-top computer or terminals where there includes a card reader for a secure smart card to be inserted (col.8, lines 20-24). The claimed node is the prior art's desktop computer or terminal that can execute application programs to secure components such as the smart card or the signing devices. However, Sudia did not clarify why it would have

been obvious to execute an application program at the node that is not physically secured to/from the cryptographic processing component.

Boebert teaches there is a need for a mechanism for extending the trusted path from the trusted subsystem of the host computer to the user of an untrusted computer or workstation such that provide access to the workstation for normal working station activities while shielding confidential data so that it cannot be read by software executing on the unsecured workstation (col.3, lines 14-19). The computer or workstation as recited in Boebert is the claimed node. Therefore, it would have been obvious for a person of ordinary skills in the art at the time of the invention was made to combine the teachings Sudia with the teaching of executing an application program at the node that is not physically secure of Boebert because the method ensures secure file transfers between a user of an unsecured workstation and a trusted computer while shielding confidential data so that it cannot be read by software executing on the unsecured workstation (col.3, lines 21-42).

As per claim 6: Sudia discloses verifying a digital signature wherein includes encrypting and decrypting data (col.6, lines 32-42), retrieving the digital certificate (col.10, lines 15-38), verifying the hierarchy (col.1, lines 24-38), and self-signed certificate processing (col.7, lines 45-52) within the node. Further, Sudia discloses certificate age checking in the form of time stamping (col.9, lines 13-16).

As per claim 7: Cancelled

As per claim 8: See Sudia col.11, lines 6-13; discussing the input represents a digitally signed network control message requiring verification.

As per claim 9:

Sudia discloses in an environment which is not physically secure, a cryptographic module, comprising:

a memory configured to operate within an environment which is not physically secure (**col.8, lines 21-24 and col.8, line 63 - col.9, line 23**) and to store a plurality of cryptographic processing programs, each program being invoked via one of a plurality of predefined messages; and **[(col.9, lines 3-18); Applicant's node is referred in Sudia as the trusted device or known as a smart card or the signing device. This trusted device comprises a microchip that has a microcontroller for executing programs and a crypto-unit that performs encryption/decryption and signature processes (col.8, line 63 - col.9, line 23). Therefore, Sudia does teach executing the application program and cryptographic processing within the node.]**

a processor configured to operate within an environment and to: (**col.8, line 67 – col.9, line 2**)

receive an input requiring cryptographic-related processing, (**col.7, lines 34-40**)

generates one of predefined messages based on the input, (**col.8, lines 10-11 and col.10, lines 10-14**)

transmit the message to the first one of the cryptographic processing programs, and (**col.9, lines 55-56 and col.10, lines 15-30**)

to perform the cryptographic-related processing. (**col.11, lines 9-22 and col.16, lines 35-67**)

Sudia discloses human operators work in relatively unsecured areas at desk-top computer or terminals where there includes a card reader for a secure smart card to be inserted (col.8, lines 20-24). The claimed node is the prior art's desktop computer or terminal that can execute application programs to secure components such as the smart card or the signing devices. However, Sudia did not clarify why it would have been obvious to execute an application program at the node that is not physically secured to/from the cryptographic processing component.

Boebert teaches there is a need for a mechanism for extending the trusted path from the trusted subsystem of the host computer to the user of an untrusted computer or workstation such that provide access to the workstation for normal working station activities while shielding confidential data so that it cannot be read by software executing on the unsecured workstation (col.3, lines 14-19). The computer or workstation as recited in Boebert is the claimed node. Therefore, it would have been obvious for a person of ordinary skills in the art at the time of the invention was made to combine the teachings Sudia with the teaching of executing an application program at the node that is not physically secure of Boebert because the method ensures secure file transfers between a user of an unsecured workstation and a trusted computer while shielding confidential data so that it cannot be read by software executing on the unsecured workstation (col.3, lines 21-42).

As per claim 10: Sudia discloses verifying a digital signature wherein includes encrypting and decrypting data (col.6, lines 32-42), retrieving the digital certificate (col.10, lines 15-38), verifying the hierarchy (col.1, lines 24-38), and

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self-signed certificate processing (col.7, lines 45-52) within the node. Further, Sudia discloses certificate age checking in the form of time stamping (col.9, lines 13-16).

As per claim 11: See Sudia col.7, lines 34-45; discussing transmit a function call to the first cryptographic processing program.

As per claim 12: See Sudia col.11, lines 6-13; discussing transmit the result of the cryptographic-related processing to an application program.

As per claim 13:

Sudia discusses in an environment which is not physically secure, a cryptographic module, comprising:

means, operative in the environment which is not physically secure (**col.8, lines 21-24**), for storing a plurality of cryptographic processing programs that is invoked via one of the plurality of predefined messages; (**col.8, lines 10-11 and col.10, lines 10-14**)

means, operative in the environment, for receiving an input requiring cryptographic-related processing; (**col.7, lines 34-40**)

means, operative in the environment, for generating the one of predefined messages based on the input; (**col.8, lines 45-55**)

means, operative in the environment, for transmitting the message to the first one of the cryptographic processing programs, and (**col.9, lines 9-13**)

means, operative in the environment, for performing the cryptographic-related processing. (**col.8, line 63 - col.9, line 23**)

Sudia discloses human operators work in relatively unsecured areas at desk-top computer or terminals where there includes a card reader for a secure smart card to be inserted (col.8, lines 20-24). The claimed node is the prior art's desktop computer or terminal that can execute application programs to secure components such as the smart card or the signing devices. However, Sudia did not clarify why it would have been obvious to execute an application program at the node that is not physically secured to/from the cryptographic processing component.

Boebert teaches there is a need for a mechanism for extending the trusted path from the trusted subsystem of the host computer to the user of an untrusted computer or workstation such that provide access to the workstation for normal working station activities while shielding confidential data so that it cannot be read by software executing on the unsecured workstation (col.3, lines 14-19). The computer or workstation as recited in Boebert is the claimed node. Therefore, it would have been obvious for a person of ordinary skills in the art at the time of the invention was made to combine the teachings Sudia with the teaching of executing an application program at the node that is not physically secure of Boebert because the method ensures secure file transfers between a user of an unsecured workstation and a trusted computer while shielding confidential data so that it cannot be read by software executing on the unsecured workstation (col.3, lines 21-42).

As per claim 14:

Sudia discusses a method of performing cryptographic-related functions in a node coupled to other nodes in a network environment which is not physically secure,

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the node includes an application program for handling communications with the other nodes the method comprising:

receiving in said node within the environment which is not physically secure **(col.8, lines 21-24)** an input requiring cryptographic-related processing; **(col.7, lines 34-40 and lines 53-54)**

generating in said node within the environment a predefined message **(col.8, lines 10-11)** based on the input **(col.9, line 64 – col.10, lines 2)**, the message one of a plurality of predefined message usable by of the cryptographic processing programs executed by the network node; **(col.9, lines 9-13 and lines 55-56)**

transmitting in said node within the environment a predefined message to the cryptographic processing program; **(col.10, lines 10-14)**

performing in said node within the environment, via cryptographic processing program the desired cryptographic-related operation. **(col.11, lines 9-22 and col.16, lines 35-67)**

Sudia discloses human operators work in relatively unsecured areas at desk-top computer or terminals where there includes a card reader for a secure smart card to be inserted (col.8, lines 20-24). The claimed node is the prior art's desktop computer or terminal that can execute application programs to secure components such as the smart card or the signing devices. However, Sudia did not clarify why it would have been obvious to execute an application program at the node that is not physically secured to/from the cryptographic processing component.

Boebert teaches there is a need for a mechanism for extending the trusted path from the trusted subsystem of the host computer to the user of an untrusted computer or workstation such that provide access to the workstation for normal working station activities while shielding confidential data so that it cannot be read by software executing on the unsecured workstation (col.3, lines 14-19). The computer or workstation as recited in Boebert is the claimed node. Therefore, it would have been obvious for a person of ordinary skills in the art at the time of the invention was made to combine the teachings Sudia with the teaching of executing an application program at the node that is not physically secure of Boebert because the method ensures secure file transfers between a user of an unsecured workstation and a trusted computer while shielding confidential data so that it cannot be read by software executing on the unsecured workstation (col.3, lines 21-42).

As per claim 15: See Sudia on col.11, lines 38-52; discussing returning the result of the performing to the application program.

As per claim 16: Sudia discusses the method of requests for digital generation, verification, data encryption and decryption (col.6, lines 32-42), retrieval of digital certificate (col.10, lines 15-38), verifying the hierarchy (col.1, lines 24-38), self-signed certificate processing (col.7, lines 45-52), and certificate age checking in the form of time stamping (col.9, lines 13-16).

As per claim 17: See Sudia col.6, lines 4-19 and col. 7, lines 8-15; discussing the RSA signature scheme and the MD5 scheme.

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As per claim 18: See **Sudia col.6, lines 4-19 and col. 7, lines 8-15**; discussing the RSA signature scheme and the MD5 scheme.

As per claim 19: See **Sudia col.6, lines 4-19 and col. 7, lines 8-15**; discussing the RSA signature scheme and the MD5 scheme.

As per claim 20: See **Sudia col.6, lines 4-19 and col. 7, lines 8-15**; discussing the RSA signature scheme and the MD5 scheme.

As per claim 21: See **Sudia col.6, lines 24-30**; discusses accessing a remote server via the network to retrieve cryptographic related information.

As per claim 22:

Sudia discloses a computer-readable medium that stores instructions executable by at least one processor in an environment which is not physically secure to perform a method for providing cryptographic-related functions, the method comprising:

receiving in at least one processor in the environment which is not physically secure (**col.7, lines 33-34 and col.8, lines 21-24**) a first function call from a predefined list a first function call from a predefined list of function calls (**col.8, lines 10-11 and 11, lines 8-15**) representing available cryptographic-related functions executable by the at least one processor; (**col.8, line 62 – col.9, line 18**)

generating in at least one processor in the environment a request message based on the first function call (**col.7, lines 34-40**), a for cryptographic processing to further transmit the request message representing a request for processing by (**col.11, lines 6-22 and col.16, lines 35-67**) a cryptographic processing module executed by the at least one processor; (**col.9, lines 9-18 and lines 55-56**)

transmitting in at least one processor in the environment the request message to the cryptographic processing module; and **(col.10, lines 10-38)**

performing in at least one processor in the environment the cryptographic-related processing. **(col.8, line 63 - col.9, line 23)**

Sudia discloses human operators work in relatively unsecured areas at desk-top computer or terminals where there includes a card reader for a secure smart card to be inserted (col.8, lines 20-24). The claimed node is the prior art's desktop computer or terminal that can execute application programs to secure components such as the smart card or the signing devices. However, Sudia did not clarify why it would have been obvious to execute an application program at the node that is not physically secured to/from the cryptographic processing component.

Boebert teaches there is a need for a mechanism for extending the trusted path from the trusted subsystem of the host computer to the user of an untrusted computer or workstation such that provide access to the workstation for normal working station activities while shielding confidential data so that it cannot be read by software executing on the unsecured workstation (col.3, lines 14-19). The computer or workstation as recited in Boebert is the claimed node. Therefore, it would have been obvious for a person of ordinary skills in the art at the time of the invention was made to combine the teachings Sudia with the teaching of executing an application program at the node that is not physically secure of Boebert because the method ensures secure file transfers between a user of an unsecured workstation and a trusted computer while

shielding confidential data so that it cannot be read by software executing on the unsecured workstation (col.3, lines 21-42).

Response to Arguments

5. Applicant's arguments with respect to claims 1-6 and 8-22 have been considered but are moot in view of the new ground(s) of rejection.

The claimed invention does not have any smart card limitations but does claim a node not physically secured. A smart card is not considered the node, thus, is not the physically secured limitation that application is claiming. Sudia discloses human operators work in relatively unsecured areas at desk-top computer or terminals where there includes a card reader (col.8, lines 20-24). Sudia's unsecured desk-top computers or terminals are physically there for human operators. This reads on the claimed the node is not physically secured.

However, to clarify the reason that it would have been obvious for a person of ordinary skills in the art to execute an application program at the node which is not physically secured, Boebert is brought forth. Boebert teaches there is a need for a mechanism for extending the trusted path from the trusted subsystem of the host computer to the user of an untrusted computer or workstation such that provide access to the workstation for normal working station activities while shielding confidential data so that it cannot be read by software executing on the unsecured workstation (col.3,

lines 14-19). Thus, it would have been obvious to combine Sudia and Boebert because executing an application program at the node that is not physically secure can still be extended to ensure secure file transfers between an unsecured workstation and a for the trusted computer (col.3, lines 21-42).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEYNNA T. HA whose telephone number is (571) 272-3851. The examiner can normally be reached on Monday - Thursday (7:00 - 5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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